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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Joe Stockwell

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EXAMINER

WRIGHT, PATRICIA KATHRYN

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

05/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/709,497	Applicant(s) STOCKWELL, JOE	
	Examiner P. Kathryn Wright	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I (claims 1-11) in the reply filed on March 26, 2008 is acknowledged.

Claim Objections

2. Claims 1-11 are objected to because of the following informalities: the claims currently recite [c1], [c2], etc. They do not clearly recite the claim number. The Examiner respectfully request that Applicant amend the claims to recite claim 1, claim 2, etc., for clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "small", in claim 1, is a relative term which renders the claim indefinite. The term "small" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Thus, it is not clear what Applicant considers "small protuberances".

Claim 1 recites "the plugs" in the penultimate line. There is lack of antecedent basis for the "the plugs". The Examiner believes the "plugs" should be amended to -- the plug member-- for consistency.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Carl (US Patent No. 5,497,670).

Carl teaches an apparatus for transferring pipette tips comprising a transfer plate 16 having a plurality of plug members (cylinders 26) extending therethrough. The plug members engage the pipette tips 20 disposed in a frame 18. Carl teaches the frame 18 being assembled and interlocked with the transfer plate via shafts 12, 14. The frame 18 has openings (see Fig. 5) for inserting the plugs 26 therethrough to engage the pipette tips 20. The openings hold the pipette tips 20. The frame 18, shown in greater detail in Fig. 5, includes a plurality of "small" protuberances 22, 28 extending into the openings.

As to claim 2, the plug members 26 are arranged in parallel lines separated by elongated slots (openings in the plate 16), see Figs. 4 and 7.

Regarding claim 3, the openings in the frame 18 of Carl comprise "elongated" slots separated by "elongated" rails. Note that the limitation "elongated slots" reads on

the openings in the frame in which the pipette tips are disposed, shown Fig. 5. Likewise, the limitation “elongated rails” reads on the area between the openings in which the tips are disposed, shown in Fig. 5 with hatched lines. The dimensions of the openings or slots are not defined in the claim or the specification, thus, the openings of Carl in the frame and the area in-between the openings can be considered “elongated slots” to one of ordinary skill.

As to claim 5, the plug members 26 are hollow to accept the piston 32 therein, see Fig. 6.

Claim 6 functionally describes the operation of the apparatus. Please note that a recitation with respect to the manner in which a claimed apparatus is intended to be operated fails to differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Nevertheless, Carl does, in fact, teach vertically sliding the transfer plate 16 (e.g., down) relative to the frame 18, see Figs. 4 and 7. The transfer plate 16 can be slid downward to a “retained and a released position” wherein the plugs 26 have pipette tips positioned thereon (see Fig. 4).

Regarding claim 7, the protuberances 20, 28 are in contact with the pipette tips, positioned over the plugs, when the apparatus is in the retained position as shown in Fig. 4.

As to claim 8, the protuberances 22, 28 are located between the plugs 26 when the apparatus is in a released position (i.e., when the transfer plate 16 is moved vertically downward so that the plugs engage the pipette tips).

As to claim 9, the transfer plate 16 further comprises at least one "tab member" for sliding the frame relative to the transfer plate. That is, the shaft 12 of Carl reads on the "tab member" since it allows the frame 18 to slide relative to the transfer plate 16. Nothing in the claim structurally distinguishes the tab member from the shaft of Carl.

With regard to claim 10, transfer plate 16 and the frame 18 are generally rectangular in shape, see Fig. 3.

As to claim 11, the transfer plate 16 and the frame 18 are removable from one another (i.e., separated when the transfer plate is slid upward along shafts).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carl (US Patent No. 5,497,670).

The teachings of Carl have been summarized above. Carl does not explicitly teach the transfer plate and the frame being comprised of a moldable plastic.

However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to construct the transfer plate and frame from a moldable plastic since the skilled artisan would be able determine the optimum materials of construction based on considerations such as cost, ease of manufacture, reactions with the processing agents and/or maintaining the required reaction conditions with respect to temperature.

Conclusion

10. No claims are allowed.

11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure as general background information related to Applicant's field of endeavor.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Kathryn Wright whose telephone number is 571-272-2374. The examiner can normally be reached on Monday thru Thursday, 9 AM to 6 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pkw

/Jill Warden/
Supervisory Patent Examiner, Art Unit 1797